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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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EXAMINER  
WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 07/15/2002 14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/485,903	DUPUIS ET AL.
Examiner	Art Unit	
Lauren Q Wells	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 June 2002.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 18-38 and 40-48 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 18-38 and 40-48 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

### **DETAILED ACTION**

Claims 18-38 and 40-48 are pending. The Amendment filed 6/10/02, cancelled claim 39 and amended claims 18, 20, 22, 40, 42, 43, and 45.

#### *Response to Applicant's Arguments/Amendment*

The Applicant's arguments filed 6/10/02 (Paper No. 13) to the rejection of claims 18-45 made by the Examiner under 35 USC 102 and 103 have been fully considered and deemed not persuasive.

The Applicant's amendment filed 6/10/02 (Paper No. 13) is sufficient to overcome the 35USC 112 rejections in the previous Office Action.

#### *102 Rejection Maintained*

The rejection of claims 18-21, 24-30, 40 and 42 under 35 U.S.C. 102(e) as being unpatentable over Feder et al. (5,721,026) is MAINTAINED for the reasons set forth in the Office Action mailed March 8, 2002, Paper No. 12, and those found below.

Applicant argues, "Accordingly, Applicants respectfully submit that FEDER does not disclose the recited combination, including a cosmetically acceptable medium". This argument is not persuasive. On page 15 of the instant specification, a cosmetically acceptable medium is recited as water or a mixture of water and cosmetically acceptable solvents. The Examiner respectfully points out that Feder is directed to an oil-in-water emulsion, and since the instant Application defines water as a cosmetically acceptable medium, the above stated claims are anticipated.

#### *103 Rejection Maintained*

The rejection of claims 18, 22-23, 31-38, 40-41, 43-45 and newly added claims 46-48 under 35 U.S.C. 103(a) as being unpatentable over Feder et al. in view of Dubief et al. (6,024,946) and in view of Blankenburg et al. (6,153,179) or Audousset et al. (6,106,577) is MAINTAINED for the reasons set forth in the Office Action mailed March 8, 2002, Paper No. 12, and those found below.

Applicant argues, "Since the problems, objectives, and compositions of FEDER are primarily directed to compositions other than cosmetic compositions, Applicants respectfully submit that a skilled artisan would not have been motivated to combine the teachings of FEDER with the hair treatment teachings of the secondary documents". This argument is not persuasive. The Examiner respectfully directs Applicant to Col. 11, lines 6-20, which states, "The dispersions according to the invention can also be employed in cosmetology. . . Thus, the dispersions can be incorporated into cosmetic compositions for the treatment of hair. . . The dispersions can also be employed in face mask cream compositions and also for producing dermocopies". Furthermore, it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).

Applicant argues, "Regarding FEDER and DUBIEF, Applicants note that the asserted motivation to combine the teachings of these documents is partially based on the assertion that

DUBIEF discloses a hair setting lotion. Applicants do not see such a disclosure". This argument is not persuasive. The Examiner respectfully directs Applicant to the definition of setting, "to put into a specified state:<sup>1</sup>". The Examiner respectfully points out that the composition of Dubief is relied upon to put in the hair in a specified state prior to or following perming, dyeing, bleaching, and/or straightening.

Applicant argues, "there is no motivation to combine the teachings of FEDER and DUBIEF because the composition of FEDER is directed to an alpha, omega-(dihydroxy)polydiorganosiloxane emulsion, whereas DUBIEF does not disclose an alpha, omega-(dihydroxy)polydiorganosiloxane emulsion". This argument is not persuasive. Dubief does disclose alpha, omega-(dihydroxy)polydiorganosiloxane in use for his emulsions. The Examiner respectfully directs the Applicant to Columns 2 and 3, wherein Dubief teaches silicones for use in his invention which may be insoluble or soluble in aqueous media, and may be in the form of oils, waxes, gums or resins, and teaches that polydiorganosiloxanes are preferred silicone gums.

Applicant argues, "BLANKENBURG and AUDOUSSET fail to disclose an alpha, omega-(dihydroxy)polydiorganosiloxane, let alone a siloxane that is in an emulsion. . .there is no reasonable expectation that the film forming polymers of BLANKENBURG and AUDOUSSET would even function in the composition of FEDER". This argument is not persuasive. The Examiner respectfully points out that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor

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<sup>1</sup> *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from IHSN Corporation; further reproduction

is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Hence, Blankenburg and Audousset do not need to teach alpha, omega-(dihydroxy)polydiorganosiloxanes or siloxanes in an emulsion. The Examiner respectfully points out that Blankenburg, Audousset, and Feder are all directed toward cosmetic, hair compositions and that while Feder does not expressly teach preferred insoluble polymers, Feder does teach insoluble polymers comprised of the same monomer units, as that disclosed by Blankenburg and Audousset.

### ***Unexpected Results***

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

Applicant argues, "the results of the present invention are surprising. . . In this regard, the prior art fails to disclose the recited cosmetic composition comprising an aqueous dispersion comprising at least one insoluble polymer particle, an emulsion comprising at least one non-

aminated silicone alpha, omega-disilanol, and a cosmetically acceptable medium". This argument is not persuasive. Regarding the charts on pages 20 and 22, the results are not clear and convincing. First, it is not clear what the units of measurement are regarding the aspects of "disentangling", "softness", and "feel". Hence, it is not clear whether or not these results are actually unexpected. Second, the Examiner respectfully points out that the charts on pages 20 and 22 are not commensurate in scope with instant claim 18, as the charts encompass one species of an aminated silicone alpha,omega-disilanol, one species of a medium, and two species of an insoluble polymer particle. Furthermore, the Examiner respectfully points out, as stated above, that it is applicant's burden to demonstrate unexpected results over the *closest prior art*. In the instant case, the comparative compositions are not the closest prior art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
July 2, 2002

*Russell Travers*  
PRIMARY EXAMINER  
GROUP 1200